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LEVINE, ADAM L				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/624,325

Applicant(s)

DESAI, WEALTHY

Examiner

ADAM LEVINE

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 6-16, 19-30, 32, 34-44, 47-58, 60, 62-72 and 75-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6-16, 19-30, 32, 34-44, 47-58, 60, 62-72 and 75-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's amendments and remarks filed March 10, 2009, are responsive to the office action mailed December 10, 2008. In this response, applicant has amended claims 1, 29, and 57. Claims 1-2, 4, 6-16, 19-30, 32, 34-44, 47-58, 60, 62-72, and 75-85 are pending and examined in this office action.

Response to Arguments

Pertaining to rejection of claims under 35 USC 103 in the previous office action

Applicant's arguments with respect to claims 1-2, 4, 6-16, 19-30, 32, 34-44, 47-58, 60, 62-72, and 75-85 have been considered but are moot in view of the new ground(s) of rejection. Despite the fact that the prior art clearly discloses purchasing ads online (see at least Lamburt figs. 3, 10-19, 21, 43-44, and column 5 lines 47-58) applicant continues to argue that the "purchase ads online" option does not actually mean that the ads can be purchased online, but that an "ordinarily skilled artisan" would rather interpret the disclosure to mean that the ordering options and actual purchase would only take place upon interaction with a sales representative. The examiner continues to find applicant's arguments unpersuasive. In addition, even if applicant's argument were accepted, the claims would read upon the prior art because there is nothing in them to distinguish them even from applicant's interpretation of the prior art. Finally, the examiner further believes that the elements that applicant argues are missing from the cited art:

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("receiving an order request from the customer via the Web site to place the order for the particular, unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer."

And

"soliciting at the Web site the customer to place an order via the Web site for the particular, unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer;")

are old and well known in the art. Nonetheless, given the repeated arguments on both sides and the fact that the Lamburt and Superpages references are so similar, the examiner feels that it may be more productive to introduce another reference to further clarify that these limitations are common in the prior art.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claim s 29-30, 32, 34-44, and 47-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim elements "means for soliciting... a selection," "means for receiving... at least one request...", "means for generating a customized price quote...", "means for soliciting... the customer to place an order...", "means for receiving an order request...", "means for receiving... information...", "means for receiving... a selection...", "means for receiving confirmation...", "means for generating an order confirmation...", and "means

for sending the customer an email...,” are means (or step) plus function limitations that invoke 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. The specification contains only the merest of implications of a general structure by describing the system as utilizing the internet. There is no disclosure of the specific structure, material, or act connected with each of these functions. The corresponding structure is required to be more than simply a general purpose computer or microprocessor. Aristocrat Technologies v. International Game Technology, 86 USPQ 2d 1235 (Fed. Cir. 2008); Net MoneyIN Inc. v. VeriSign Inc., 88 USPQ 2d 1751 (Fed. Cir. 2008). Disclosing only a general purpose computer as the structure or simply reciting “software” without providing detail about the means to accomplish the function is insufficient. Descriptions of the outcome of the claimed functions is not a description of the structure, i.e. the computer programmed to execute a particular algorithm.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so

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that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 29-30, 32, 34-44, and 47-56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As further explained above, there is no disclosure of specific structure, material, or acts connected with the claimed means.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-2, 4, 6-16, 19-30, 32, 34-44, 47-56 and 85 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 1-2, 4, 6-16, 19-28, and 85, are directed to a process that does nothing more than manipulate an abstract idea. Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter upon an otherwise abstract idea.

The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products," while a "process" consists of a series of steps or acts to be performed. For purposes of section 101, a "process" has been given a specialized, limited meaning by the courts. Based on Supreme Court precedent and recent Federal Circuit decisions, a process must (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process. See *In re Bilski*, 2008 U.S. App. LEXIS 22479. An

example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

A claim that involves a process that transforms a particular article may be patentable under § 101. See *Diehr*, 450 U.S. at 184 (holding a process that involved calculations using the "Arrhenius equation" patentable because the claim "involve[d] the transformation of an article, in this case raw, uncured synthetic rubber, into a different state or thing"). Processes involving mathematical algorithms used in computer technology may be patentable if they are tied to a specific machine or apparatus. Mental processes—or processes of human thinking—standing alone are not patentable even if they have practical application.

In order to qualify as a statutory process, therefore, claims should positively recite the machine or apparatus to which they are tied, for example by identifying the machine or apparatus that accomplishes the method steps, or they should positively recite the particular article that is being transformed, for example by identifying the material that is being changed to a different state. The mere manipulation of data is not transformation of a particular article. There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data

gathering or outputting, is not sufficient to pass the test. These claims recite no tie to any machine or apparatus and do not transform any particular article.

Claims 29-30, 32, 34-44, and 47-56, provide for the use of various means, but since the claims do not set forth any machine, apparatus, or steps involved in a method/process, it is unclear what apparatus, process, or other statutory class applicant is intending to encompass. A claim is indefinite where it merely recites the use of intangible or abstract elements. Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture does not confer statutory subject matter to an otherwise abstract idea. System components as claimed (means) are lacking structural specificity and are potentially purely software components. If so, the claims are directed at a computer program not claimed as embodied in a computer-readable medium and as being implemented in a computer apparatus.

Computer programs claimed per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer that permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program, data structure(s) and other software, and the computer hardware components that permit the

computer program's functionality to be realized, and it is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions. MPEP 2106 IV B 1 (a).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-2,4,6-15,19-23,29-30,32,34-43,47-51,57-58,60,62-71, 75-79 and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamburt (Paper #20061105; US Patent No.6,374,241) in view of Superpages (a collection of prior art cited in Paper # 050715, PTO-892, items U1-X7; See MPEP §2131.01) and further in view of Wagner et al. (Paper # 20080627; US Patent No. 7,062,466 B2).**

Lamburt teaches a providing a business directory, soliciting orders for listings in a business directory, providing a website accessible by customers, displaying listing options and enhancements available to customers for enhancing their business listings, and displaying price quotes for customized business listings. For example, Lambert discloses a method for providing a Web site accessible by a customer and receiving an order request from the customer via the Web site to place an order for the particular, unique, individualized, customized business listing in a business directory including the

first and second optional listing enhancements requested by the customer (see at least figs.10-22, column 5 lines 47-58). Lamburt further discloses:

- displaying at the Web site a list of multiple individually selectable available optional listing enhancements: (see at least abstract, figs.16-22,36, column 10 lines 45-53, column 54 lines 33-53);
- soliciting at the website a selection by the customer: of one or more of the optional listing enhancements (see at least figs.16-22, column 10 lines 45-53, column 54 lines 33-53).
- receiving at least one request from the customer via the Web site: to include at least one feature in the listing of the business in the business directory, including receiving a first enhancement request from the customer via the Web site to include in the listing of the business in the business directory a first optional listing enhancement from the list of available optional listing enhancements, and including receiving a second enhancement request from the customer via the web site to include in the listing of the business in the business directory a second optional listing enhancement from the list of available optional listing enhancements, whereby the customer configures a particular, unique, individualized, customized business listing, request from the customer to place the order for the listing of a business in a business directory including the at least one optional listing enhancement requested by the customer (see at least abstract, figs.16-22,36, column 10 lines 45-53, column 54 lines 33-53);

- generating a customized price quote: for the particular, unique, individualized, customized business listing configured by the customer, ordered by the customer, wherein the step of generating the customized price quote includes calculating the customized price quote based on the particular features requested by the customer to be included in the particular, unique, individualized, customized business listing (see at least figs.16-17,19-20,33); displaying the customized price quote for the particular, unique, individualized, customized business listing at the website to the customer (see at least figs.16-22, column 10 lines 45-53, column 54 lines 33-53);
- the business directory is a classified business directory: (see at least figs.3,9-22,43-44);
- displaying to the customer at the Web site a solicitation to enhance the listing: with at least one optional listing enhancement, wherein the at least one optional listing enhancement can be purchased with an associated fee (see at least figs.16-22); receiving listing information from the customer at the Web site, wherein the listing information includes basic business information (see at least figs.16-22).
- receiving listing information from the customer at the Web site: the listing information including at least one of business market information, business category information and optional listing enhancement information relating to the placement and/or appearance of the listing in the business directory: basic business information including a business name, a business address, and a

business telephone number, business market information including a region or market in which the customer wishes the business listing to appear, business category information including at least one business category under which the customer wishes to list the business in the business directory, also providing for at least two categories under which the customer wishes to list the business in the business directory (see at least figs.9,11-17,19-21,41,44,54-58,68-70); displaying at the Web site a list of available business categories and subcategories and receiving from the customer at the Web site a selection of a business category and subcategory from the list of available business categories and subcategories (see at least figs.9,11-17,19-21,41,44,54-58,68-70).

- receiving listing information from the customer at the Web site: the listing information including at least one of business market information, business category information and optional listing enhancement information relating to the placement and/or appearance of the listing in the business directory: including optional listing enhancement information that includes graphical and/or textual indicia the customer wishes to appear on the listing in the business directory, the graphical and/or textual indicia including at least one of a customer Web site link, a customer email link, enhanced text, listing highlighting, and a link to a supplemental listing, including a link to an enhanced listing, further including receiving supplemental information from the customer at the Web site that the customer wishes to be displayed when the link to the supplemental listing is accessed by a directory user, and also including receiving enhanced text

information from the customer at the Web site that the customer wishes to appear on the listing in the business directory (see at least figs.3,9,15-22,42,44,46,54-55; column 1 lines 8-34, column 10 lines 45-56).

- displaying at the web site a solicitation for billing information from the customer:
including instructions directing the customer to enter billing data, receiving billing information from the customer at the Web site (see at least fig.22. Please note: The customer's identifying information, whether it is called contact information or billing information, is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).
- displaying a statement of terms and conditions to the customer at the Web site:
and receiving confirmation of acceptance of the terms and conditions from the customer at the Web site (see at least figs.19-20, column 18 lines 14-29).
- generating an order confirmation and displaying it to the customer: at the Web site (see at least abstract, figs.19-20,22,36; column 10 lines 18-45. Please note: it is an inherent aspect of the "Purchase Ads Online" option and the option to see how the listing appears that the order confirmation would then be displayed to the customer, at least in the form of showing the customer's listing).

- the order serving to provide enhancements to an existing business listing: in the business directory (see at least figs.16-17,19,54-55; column 10 lines 45-51, column 55 line 48-column 56 line 37).
- business directory is an online business directory: (see at least figs.9-22).
- sending the customer an email: including information regarding the order for the listing in the business directory (see at least fig.22; column 16 lines 32-50);
- soliciting at the web site the customer to place an order via the web site: for the particular unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer (see at least figs. 3, 10-19, 21, 43-44, and column 5 lines 47-58).

Lamburt teaches all the above as noted. Lamburt teaches a) providing a business directory, b) soliciting orders for listings in a business directory, c) providing a website accessible by customers, d) displaying listing options and enhancements available to customers for enhancing their business listings, and e) displaying price quotes for customized business listings. Lamburt however does not disclose the second optional listing enhancement selectable by the customer independently of the first optional listing enhancement. Superpages teaches a) providing a business directory, b) soliciting orders for listings in a business directory, c) providing a website accessible by customers, d) displaying listing options and enhancements available to customers for enhancing their business listings, and e) displaying price quotes for customized business listings. Superpages further teaches the second optional listing

enhancement selectable by the customer independently of the first optional listing enhancement (see at least items U2, V5, W3, W5, and X3). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Lamburt to explicitly disclose the second optional listing enhancement selectable by the customer independently of the first optional listing enhancement, as disclosed by Superpages, in order to fully realize the greater utility inherent in the disclosure, and thereby allow the invention to achieve greater use in commerce.

Lamburt in view of Superpages teaches all the above as noted. Lamburt in view of Superpages teaches a) providing a business directory, b) soliciting orders for listings in a business directory, c) providing a website accessible by customers, d) displaying listing options and enhancements available to customers for enhancing their business listings, and e) displaying price quotes for customized business listings. Although it is the examiner's position that "soliciting at the Web site the customer to place an order via the Web site for the particular, unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer," and "receiving an order request from the customer via the Web site to place the order for the particular, unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer," are disclosed by Lamburt (see at least figs. 3, 10-22, 43-44, and column 5 lines 47-58), the reference fails to explicitly show the actual step indicating the transaction taking place online. Applicant argues that in this unique situation a person of ordinary skill in the art would interpret that as indicating the

actual transaction does not take place online and that the above two elements are therefore not actually present. Although no evidentiary support has been provided by the applicant for this position the examiner is providing an additional reference within the body of the rejection (see "response to arguments") to fully establish that this position is not credible. Wagner teaches a) providing a business directory, b) soliciting orders for listings in a business directory, c) providing a website accessible by customers, d) displaying listing options and enhancements available to customers for enhancing their business listings, and e) displaying price quotes for customized business listings, and Wagner further teaches:

- soliciting at the Web site the customer to place an order via the Web site: for the particular, unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer (see at least abstract, fig. 1, column 1 lines 20-40, column 2 lines 1-18);
- receiving an order request from the customer via the Web site: to place the order for the particular, unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer (see at least abstract, figs. 3-5, column 5 line 54 – column 6 line 3).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Lamburt to explicitly disclose the transaction taking place online, as disclosed by Wagner, in order to fully realize the greater utility

inherent in the disclosure, and thereby allow the invention to achieve greater use in commerce.

Pertaining to system Claims 29-30, 32, 34-44, and 47-56

Rejection of Claims 29-30, 32, 34-44, and 47-56 is based on the same rationale as noted above (Please note: the means for accomplishing each step of the method as disclosed in the reference is either disclosed or inherent in each specific section of the reference that discloses the step in the method).

Pertaining to computer program product Claims 57-58, 60, 62-72, and 75-84

Rejection of Claims 57-58, 60, 62-72, and 75-84 is based on the same rationale as noted above. In addition, Lamburt discloses a computer program product (see at least abstract, column 22 line 66-column 23 line 11, column 68 lines 16-39).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Wagorn et al., US Pub. No. 2002/0002509 A1 (Jan. 3, 2002): Teaches a method and system for enabling users to post and view trade lead notices. Maintains a central database used for storing trade lead notices, correlates a sub-selection of advertisements with a particular user of the system dependent upon the data profile associated with that user and provides on-line auctions, integrated payment and shipping services, as well as website and catalogue hosting services.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM LEVINE whose telephone number is (571)272-8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine
Patent Examiner
July 2, 2009
/Adam Levine/
Examiner, Art Unit 3625